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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,601	06/22/2000	Ian A. Stewart	WRLD-1-1007	8908

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EXAMINER

FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 11/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/602,601

Applicant(s)

STEWART, IAN A.

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-6** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, at issue is the claim limitation “above a criteria” and “below a criteria” as recited in claim 1, lines 6,8,9; and claim 4, lines 13, 15 and 18. Specifically, applicant discloses whether a test is acceptable or not, and not necessary whether a test is “above” or “below” a criterion (See block 84 and 90 in figure 3; block 104 in figure 4, and corresponding written description on page 4, line 18 through page 5, lines 20). Examiner notes the teaching of “criteria” in the corresponding written description relates to “pinging” (see page 5, lines 15-18); however, absent from the teachings is the specific reference to “above” and “below” a criteria. Thus it is unclear how one skilled in the art would determine if a test is “above” or “below” a criteria. Examiner also notes with respect to claims 2 and 5 that it is also unclear how one skilled in the art would test a subnetwork that does not include the user system. As the dependent claims depend on the independent claims, these claims also stand rejected.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. **Claims 1-6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it is unclear what applicant means by “above” and “below” a criteria as recited in claims 1 and 4. See similar claim analysis above for the 112-first paragraph rejection. As the dependent claims depend on the independent claims, these claims also stand rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,006,267 to *Nguyen et al.* (“*Nguyen*”) in view of U.S. Patent No. 6,169,741 to *LeMaire et al.* (“*LeMaire*”).

Examiner has made assumptions in order to overcome the 112-first and 112-second paragraph rejections. In particular, examiner assumes that the items at issue for the 112-first paragraph rejection would have been obvious to one skilled in the art prior to applicant's invention and that the term “meet” is equivalent to “above” and/or “below” a threshold for the second paragraph rejection.

As to **claim 1**, *Nguyen* discloses a method and system for connecting different hosts that have different communications protocols. In particular, *Nguyen* teaches the initial steps of (1) determining if a request to receiving a multicast signal has occurred,

(2) testing the subnetwork, and (3) implementing a first multicast protocol. For example, support is provided in figure 6 of *Nguyen* [see column 5, lines 38-67].

Examiner notes that the reference is unclear on testing and using a “subsequent multicast protocol” if the result of a test for the first multicast protocol is below a certain criteria. Specifically, examiner notes the reference teaches testing to see if multicast in general is supported (i.e., if multicasting is not supported then unicast is selected).

Examiner notes that the reference also mentions that other multicast protocols (emphasis plural) are supported (see column 3, lines 23-26). Thus examiner notes that it would have been obvious to one skilled in the art prior to applicant’s invention to perform a “reachability test” (i.e., pinging) for a subsequent multicast protocol. As support, the background of *LeMaire* discloses that routers use more than one multicast routing protocol [see column 5, lines 44-55]. Thus one skilled in the art would have been motivated to look for a second multicast routing protocol if a first multicast routing protocol is not present. In other words, one skilled in the art would have been motivated to repeat testing a subnetwork until the device finds a compatible multicast routing protocol such that one possible motivation would be for compatibility. Examiner notes that *Nguyen* further teaches the concept since if a first protocol is not “compatible” then one skilled in the art is motivated to use a second “compatible” protocol (i.e., *Nguyen* teaches selecting the most optimal means for disseminating information from one host to more than one host) [column 1, lines 44-55]. Finally, examiner notes that applicant fails to disclose how a test is performed for a second multicast routing protocol. In other words, applicant’s specification teaches using a PING test as a first test for a first

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multicast protocol (e.g., as disclosed in figure 5). Applicant is silent or deficient to using a PING test to test for a subsequent multicast protocol (e.g., as shown in figure 5). Thus examiner notes that a receipt of any message would suffice as supported in applicant's written disclosure on page 5, lines 1-3 since applicant does not provide a further relationship between a message and a PING test (i.e., figure 5 only supports a PING test for the PIM protocol). Thus examiner notes a reasonable but broad interpretation of a test for a subsequent multicast protocol.

As to **claim 2**, examiner notes a reasonable but broad interpretation of "not include the user system".

As to **claim 3**, *LeMaire* teaches using a default multicast protocol using a reasonable but broad interpretation of "default".

As to **claim 4**, see the rejection for claim 1.

As to **claim 5**, see the rejection for claim 2.

As to **claim 6**, see the rejection for claim 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Derrick W. Ferris
Examiner
Art Unit 2663

DWF
DWF

[Signature]
CHI PHAM
SUPERVISORY EXAMINER
TECHNICAL CENTER 2600 *cd/28/07*